

### **REMARKS**

In response to the Office Action of September 25, 2006, applicants respectfully request reconsideration and allowance of the claims in their original form.

By this amendment applicants have submitted for the Examiner's review a Replacement Sheet of drawings in which the lines and reference characters are believed to be in conformance with the requirements of the Patent Office.

Applicants have also provided new pages of claims 1-10 wherein the claims have all been indicated as being the original claims as filed.

With respect to the issue of enablement applicants respectfully submit that their invention is directed to one skilled in the art to which the present invention pertains. Therefore, the disclosure of the types and chemical or physical composition of the materials employed in the device of this invention would be well known in the art and commercially available.

With respect to the Kurth et al reference cited by the Examiner, applicants respectfully submit that claims 1-5, 7 and 10 are not anticipated under 35 USC 102(b) by this reference.

Kurth et al discloses and claims, as noted by the Examiner, a toe aeration appliance. As indicated at column1, lines 38 et seq., of Kurth et al it is stated that the invention is designed to fill a modern day need: i.e. to supply oxygen and remove moisture from the toes.

In contrast to Kurth et al, applicants' invention has nothing to do with toe aeration or

moisture control of the area between two or more toes. Hence, the configuration of the patentee's appliance is designed for a different purpose than the present invention. Applicants' device is designed specifically to protect irritation due to wearing of thong-type sandals and other similar footwear.

A careful examination and comparison of the drawings and claims will show that in applicants' invention it is the web space between adjacent toes, particularly the web space between the big toe and the adjacent toe where irritation occurs when the wearer of sandals is in motion. In order to obtain minimize friction, the device must have a specific configuration as shown in applicants' drawings and more particularly as claimed in the application.

Figure 2 of the reference is indicated to be an end view of the front view of Figure 1. Reference character 12 of Figure 2 is described in the Kurth et al reference as the base portion of the toe aeration appliance. Reference character 14 is the spacing portion. However, there is no showing in the Kurth et al figures of a combination of the plantar base zone, dorsal flap, or web space as recited in the claims. The entire left side of the when it is worn is flat. In contrast in applicants' device as shown for example in Figure, 4, when worn, the device bends around the area of the web space to protect the skin of the around the web space.

For an invention to be anticipated by the prior art, each and every feature of the claimed invention must be shown by the reference. Kurth et al fails to show each and every aspect of the present invention as shown in the drawings and claims. Withdrawal of the rejection is therefore respectfully requested.

Applicants have also carefully reviewed the Crunkleton reference and respectfully

submit that claims 3,6 and 10 are not anticipated under 35USC 102(e). This reference is directed to a method and device for the symptomatic relief for soft corns.

In Figure 3 of this reference the patentee discloses a spacer 12 and a dam 14 which are employed in his invention. Evidently, spacer 12 maintains separation of the toe while the corn is treated and while dam 14 prevents spillage of the material applied for the treatment.

Neither of these features are part of applicants' claimed invention.

However, the Examiner has made reference to Figure 5 and the description in paragraph 36 of Crunkleton's specification. Figure 5 depicts a mold formed after application of the mold material using the mold applicator of the reference. Applicants respectfully submit that the mold 40 is not of the same configuration as the protective device disclosed and claimed in claims 3, 6 and 10 which depend on claim. Claim 1 as noted above, specifies a particular configuration which is not shown in the reference. The mold of the reference occupies most of the space between the toes as shown in Figure 5a, whereas when one is wearing sandals the thong fits closely against the web space,

Again, applicants respectfully submit that each and every feature of applicants' invention is not shown in the Crunkleton reference. Applicants further submit that in determining anticipation one must take into consideration the intended use of the appliance or device. In the present case neither reference cited by the Examiner discloses the use of a device for the protection against frictional irritation of the web space due to wearing thong-type sandals. Withdrawal of the rejection is therefore respectfully requested.

Applicants also submit that claims 8 and 9 of the present invention would not have been obvious under 35 USC 103(a) over the Kurth et al reference in view of the

Dumitrascu reference. As discussed above, the primary reference discloses a toe appliance for aeration and moisture absorption. The secondary reference is directed to an adhesive skin protection patch for the forefoot. Since the references are directed to different aspects of footcare, one of ordinary skill in the art would find no suggestion or incentive to combine the references in the manner indicated by the Examiner

Applicants respectfully submit that one must not lose sight of the statutory provisions under which patents are granted to inventors to protect their discoveries. Section 102 of Title 35 indicates that the right of an inventor to a patent is a positive one; that is the inventor shall be entitled to a patent, unless one or more of the subdivisions of the section are applicable. Moreover, Section 103(a), when read in light of the preceding section, must also be considered from the premise that an inventor shall be entitled to a patent, unless the subject matter as a whole would have been obvious to one of ordinary skill in the art at the time the invention was made. Hence, the invention in question must be obvious from the reference to that person who has ordinary skill and who is unaware of and has no knowledge of applicants' discovery. In other words, applicants' invention must manifest itself, or stand out from the teachings of the reference. It must not be hidden in the teachings of the references only to be uncovered by one who is viewing the art with the knowledge gleaned from applicants' invention.

While it is often possible to select from the prior art elements which will approximate the invention shown in the application, the fact that such selection can be made does not necessarily preclude the presence of a patentable invention. The test to be given to determine whether an invention is obvious is the "fair suggestion"

test. There must be a "fair suggestion" from the prior art as to what applicants have done. It is respectfully submitted therefore, that when the claims under consideration are rejected as being unpatentable over the cited art, that the test to be employed is one of "fair suggestion". It is imperative that the "fair suggestion" test be employed in arriving at a decision. The basic reason for the "fair suggestion" test is based on the fact that the Examiner had had an opportunity to consider and to digest applicants' disclosure prior to searching the art. As such, it is relatively easy for the Examiner to unintentionally hold that the reference teaches the invention under consideration. It is only when the reference "fairly suggests" the claimed invention that the rejection is proper, and this "fair suggestion" test must be approached without having recourse to the disclosure of appellant's application. (in re Lunsford, 148 U.S.P.R 721).

For each of the foregoing reasons, applicants submit that the claims in their present form are in condition for allowance. Early, favorable action is therefore respectfully requested.

Respectfully submitted.

William R. Moran  
Reg. No. 19,555  
Attorney for applicants